

REMARKS

Status of the Claims

Claims 1-16, 19, and 22-49 are currently pending in the application. Claims 1-16 and 24-49 are withdrawn as directed to a non-elected invention. Claims 19 and 23 are amended to cancel any reference to Chinese hamster fucose transporter gene suppression. Claims 17-18 and 20-21 were previously cancelled. The claims are amended without prejudice or disclaimer. No new matter has been added by way of this amendment. Reconsideration is respectfully requested.

Issues Under 35 U.S.C. § 102(e)

The rejection of claims 19, 22, and 23 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. 2004/0110282 to Kanda *et al.*, ("Kanda"), is maintained. The Examiner states that Kanda describes Chinese Hamster Ovary ("CHO") cells and a nucleic acid, *i.e.*, SEQ ID NO: 35, which encodes the Chinese hamster fucose transporter, *see Office Action*, page 4. According to the Examiner, Kanda anticipates the instant claims because an ordinary artisan would recognize that a CHO cell comprises genomic DNA, which comprises the cDNA of SEQ ID NO: 35, in total or as exon fragments, *see Office Action*, page 4. Based upon the foregoing, the Examiner believes that since Kanda allegedly teaches disruption of the Chinese hamster fucose transporter genomic DNA, Kanda inherently teaches disruption of SEQ ID NO: 1, as specified in the instant claims. Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Court of Appeals for the Federal Circuit has found that "[t]o anticipate, the reference 'must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)); see also, e.g., *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) ("[The] reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the

[invention] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference” (emphasis in original)).” *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075, 1083 (Fed. Cir. 2008).

As amended, claim 19 is directed to an isolated Chinese hamster cell, wherein the genomic Chinese hamster fucose transporter gene having the sequence of SEQ ID NO: 1, is disrupted. Accordingly, the claims, as amended, do not encompass an isolated Chinese hamster cell, wherein the expression of a Chinese hamster fucose transporter gene is suppressed by, *e.g.*, RNAi.

In contrast to the instant claims, Kanda lists various general methods of suppressing gene expression. Kanda does not expressly disclose a method for disrupting the genomic CHO fucose transporter gene. Instead, Kanda expressly discloses a method of preparing cells, which express GDP-fucose transporter dominant negative mutants, wherein an N-terminal-deletion mutant of human GDP-fucose is introduced, *see* Example 1 of Kanda. Applicants submit that it is impossible to completely disrupt the fucose transporter gene by the method disclosed in Kanda.

The isolated Chinese hamster cell of the instant claims, wherein the genomic Chinese hamster fucose transporter gene, having the sequence of SEQ ID NO:1, is disrupted, may be accomplished, for example, by homologous recombination. To disrupt the genomic fucose transporter gene, however, knowledge of the full length sequence of the target genomic gene is needed. As indicated in the response to the previous office action, Kanda only discloses the partial sequence of GDP-fucose transporter gene (SEQ ID NO:35). Kanda does not disclose, SEQ ID NO:1, which is the full length sequence of the fucose transporter gene of a CHO cell.

As noted above, Kanda only generally discloses methods of suppressing gene expression. Further, Kanda fails to disclose an isolated Chinese hamster cell, the genomic Chinese hamster fucose transporter gene, having the sequence of SEQ ID NO: 1, is disrupted. Thus, to arrive at the claimed invention one skilled in the art would need to pick, choose and combine various disclosures in Kanda not directly related to each other, and thus, Kanda cannot anticipate claims 19, 22, and 23. See the discussion above regarding holdings of The Court of Appeals for the Federal Circuit in *Sanofi-Synthelabo v. Apotex, Inc.*

Based upon the foregoing, the instant claims are novel over the cited reference. Withdrawal of the rejection is respectfully requested.

Objections to the Specification

The Examiner objects to the instant application because it contains an embedded hyperlink and/or other form of browser-executable code. The application is amended to delete the hyperlink. Accordingly, the objection is overcome and withdrawal of the objection is respectfully requested.

Issues under 35 U.S.C. § 112, First Paragraph

Claims 19, 22, and 23 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner states that both suppression and disruption of the described gene is not supported by the present application, *see Office Action*, page 5.

As noted above, claims 19 and 23 are amended to cancel the phrase “expression of a Chinese hamster fucose transporter gene is suppressed and.” Accordingly, the rejection is overcome and Applicants respectfully request withdrawal.

Double Patenting

Claims 19, 22, and 23 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-8 of co-pending Application No. 11/793,649.

Applicants respectfully request that this provisional rejection be held in abeyance until there is an indication of allowable subject matter in one of the co-pending applications.

CONCLUSION

In view of the above amendment and remarks, Applicants believe that the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Linda T. Parker, Reg. No. 46,046, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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